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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/091,735	06/24/1998	IAN DUNCAN BRAMHILL	36-1230	5276

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EXAMINER

NGUYEN, CUONG H

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 01/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/091,735

Applicant(s)

Bramhill et al.

Examiner

Cuong H. Nguyen

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Aug 28, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 12, 14-18, 21-26, and 28-33 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 12, 14-18, 21-26, and 28-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

1. This Office Action is the answer to the Appeal Brief and the amendment received on 8/28/2002; which papers have been placed of record.

2. Claims 1-30 are pending in this application; claims 9-11, 13, 19-20, and 27 have been canceled; claims 28-33 have been added.

Response:

3. USPTO decides to reopen prosecution for this case since after reviewing and discussing in 2 separate Appeal Conferences about the pending invention, all reviewing parties confirmed that pending claimed languages are not patentable; however, better prior art should be given to show obviousness. The examiner, orally, gave the related information about read-on matters and corresponding references in a telephone interview on 11/14/2002.

Restriction/Election

4. The examiner submits that group I contains: claims 1-8, 12, 14-18, 21, 28-33 for a subject matter of "protecting data" with US classification: 705/57; and group II contains claims 22-26 for a subject matter of "downloading data from a server to a client" with US classification: 380/28

These 2 groups create 2 separate inventions as defined by 2 above distinguished US classes.

An election for one of above 2 groups of claims is requested (for this action, group I is assumed to be selected).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.

5. Re. To claim 29: It is an independent claim about a computer program carrier medium, but fails to particularly pointing out and distinctly claiming the subject matter that the applicants regards as their invention (please note that referring to "claim 28" should not be used for an independent claim).

This claim calls for an article of manufacture; however, it is directed to "a method" (to implements the functions of the server (the examiner questions that what functions of the server are claimed in claim 29) combining with an article of manufacture (process and product in a same claim), its limitations are not conforming to the required claim's format (See *Ex parte Lyell*, 17 USPQ2d 1548 - Bd. Pat.Appl & Inter. 1990).

According to *Ex parte Lyell*, claim 29 is held to be ambiguous and properly rejected under 35 USC 112, 2nd para.; such claim is also rejected under 35 USC 101 based on the

theory that the claim is directed to neither a "process" nor a "article of manufacture" but rather embraces or overlaps two different statutory classes of invention set forth in 35 USC 101 which is drafted so as to set forth the statutory classes of invention in the alternative only.

6. Re. To claims 31-33: They are directed to a method/a server for protecting data; however, the final results after performing these claims are achieving data in their unprotected forms, comprising "repeated" steps/components of:

- a client requests specific data from a server, this is inherently done by claiming that: "running a program portion at the client, the program portion generating and uploading to the server a request for access to data" (please note that normally, a server would distribute an available "template"/ (program to request a particular software), then a client would enter requester's name/address; a specific software he needs and uploading those data to the server, those steps has been happening before the application's priority date);
- encrypting the data;
- sending protected data to client; and
- converting said protected data to unprotected forms, and prevent copying said unprotected forms.

These claims fail to particularly pointing out and distinctly claiming the subject matter that the applicant regards as their invention (i.e., the method as claim achieving unprotected data instead of achieving protected data as set forth in the preamble).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 in view of the AIPA and H.R. 2215 that forms the basis for the rejections under this section made in the attached Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

35 U.S.C. § 102(e), as revised by the AIPA and H.R. 2215, applies to all qualifying references, except when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. For such patents, the prior art date is determined under 35 U.S.C. § 102(e) as it existed prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

7. Claims 1-2, 5-6, 12, 28, 30-33 are rejected under 35 U.S.C. § 102(e) as being anticipate by **Spies** et al. (US Pat. 6,055,314).

A. Re. to claims 30-33: **Spies** et al.'s patent is directed to a method/a server for protecting data, comprising repetition steps/components of:

- a client requests specific data from a server, this is inherently done by "running a program portion at the client , the program portion generating and uploading to the server a request for access to data"; (see **Spies** et al., Fig.2)
- encrypting the data (see **Spies** et al., Fig. 3, ref. 66 wherein a video encryption device having said claimed capability);
- sending protected data to client (see **Spies** et al., claim 3 (i.e., 17:40-45)); and
- converting said protected data to unprotected forms, and preventing output data from being copied (this is analogous to a statement of "the viewer is considered to have the ability to record and redistribute the video with little difficulty") (see **Spies** et al., Fig. 12, ref. 338, and 1:45-49)).

The examiner also submits that claim 32 is a "system" claim for a server comprising weighted limitations for related components claiming in that server:

- an input for receiving a request (see **Spies** et al. Fig.1, i.e., an I/O interface of computer system 44);
- protecting means for cryptographically protecting the request data (see **Spies** et al., Fig. 3, ref. 66).

- generating means for generating computer data/(note: "a program portion" is not distinguished from data/instruction as in "system" claim 32); (see **Spies et al.**, Fig. 9, ref. 206, and 8:31-33).

B. Re. To claims 1, 28: The examiner submits that they contain limitations as in rejected claim 31; therefore, similar rationales and reference set forth for 35 USC 102(e) rejections are applied.

C. As per claim 2: **Spies et al.** suggests a method that includes protecting data by encryption (see **Spies**, 16:57-64).

D. As per claim 5: **Spies et al.** suggests a method that including, checking that a client is permitted to receive data (see **Spies**, claim 16).

E. As per claim 6: **Spies et al.** suggests a method that including identifying a client to a server before sending data (see **Spies**, claim 16).

F. As per claim 12: **Spies et al.** suggests a method, wherein data are sent to a client from a server through a network (see **Spies**, Fig. 9).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to

be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3-4 are rejected under 35 U.S.C. §103(a) as being unpatentable over **Spies** et al. (US Pat. 6,055,314), in view of **Rhoads** (US Pat. 5,841,978).

A. As per claim 3: In addition to **Spies**, **Rhoads** further discloses a method that comprises protecting an integrity of the data in a computer related field(see **Rhoads**, 57:5-35).

Because protecting cryptographical data is obvious with protecting data (because they, both, merely are data, and protecting cryptographical data is similar as protecting specific data); therefore, it is obvious to perform a common step: protecting data.

B. As per claim 4: **Spies** et al. also suggest a method that including a hashing algorithm for data integrity (see **Spies**, 7:31-35).

It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated **Rhoads** suggestion to **Spies** invention to suggest above claimed step because it would simply prevent any change to original data.

9. Claim 7 is rejected under 35 U.S.C. §103(a) as being unpatentable over **Spies** et al. (US Pat. 6,055,314).

Spies et al. obviously suggest:

- generating a program at a server;
- downloading said program to a client, and

- running said program on the client to request a server for a protected data.

These above limitations are obviously suggested in **Spies**, 16:19-40 & claim 11.

The examiner also submits that normally, a server would distribute an available "template"/ (program to request a particular software), then a client would enter requester's name/address; a specific software he needs and uploading those data to the server, those steps has been happening before the application's priority date.

10. As per claim 8: This claim is rejected under 35 U.S.C. §103(a) as being unpatentable over **Spies** et al. (US Pat. 6,055,314).

Spies et al. also obviously suggest that program is generated in response to a request for access to a specific data (see 16:20-39).

(please note that "a program portion" as claimed is "a non-functional material"; therefore, it can be interpreted as queries, or template .etc.

11. As per claim 14: This claim is rejected under 35 U.S.C. §103(a) as being unpatentable over **Spies** et al. (US Pat. 6,055,314).

Spies et al. obviously suggest said program includes data concerning a cryptographic key, and the method including using the key to render the downloaded cryptographically protected data into an unprotected form.

This claim is interpreted as a method as in claim 7, comprising a cryptographic key, and said method uses said key to unprotect download data. The examiner submits that the uses of a cryptographic key to protect/unprotect data are well known in the art (see **Spies**, 16:19-54).

12. As per claim 15: This claim is rejected under 35 U.S.C. §103(a) as being unpatentable over **Spies** et al. (US Pat. 6,055,314), in view of **Probst** (US Pat. 5,982,899).

In addition to **Spies**'s disclosure, **Probst** obviously suggests a server and a client each hold data corresponding to a cryptographic key and a machine identifier for uniquely identifying the client, the method including:

- sending a challenge to the client (this feature is very well-known), such that it generates a signed response as a cryptographic function of the key and the machine identifier held therein (**Probst** obviously suggests an analogous action for generating a combination feature of a key and a machine identifier, see **Probst**, the abstract),
- generating from the cryptographic key and machine identifier held associated with the server, a corresponding signed response as a cryptographic function of the key and the machine identifier (see **Probst**, the abstract and 3:8-21 for obviousness in

suggesting a unique identifier by combining a key and a machine identifier);

- comparing the signed responses from the client and the server, performing the cryptographic protection of the data with the key (see **Probst**, 4:20-22, claims 5 and 15);
- converting/decrypting protected data into an unprotected form (see **Probst**, the abstract, claims 1, 15, and 3:8-21).

It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated **Probst's** suggestions to **Spies** invention to suggest above claimed steps because the claimed languages already describe familiar steps in the art to verify a client by a server.

13. As per claim 16: This claim is rejected under 35 U.S.C. §103(a) as being unpatentable over **Spies** et al. (US Pat. 6,055,314), in view of **Rhoads** (US Pat. 5,841,978).

To implement **Spies's** disclosure, **Rhoads's** patent also gave ideas of using steganographically data (see **Rhoads**, claim 1).

It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated **Rhoads's** suggestion to **Spies** invention to suggest claimed

step because it would use an available form such as steganographic marked data for data protection purposes.

14. As per claim 17: This claim is rejected under 35 U.S.C. §103(a) as being unpatentable over **Spies** et al. (US Pat. 6,055,314), in view of the Official Notice.

A method as in claim 1, including registering the client with the server.

The Official Notice is taken that in software renting business involving server/client (using Internet), a step of registering a client with a server has been well-known.

15. As per claim 18: This claim is rejected under 35 U.S.C. §103(a) as being unpatentable over **Spies** et al. (US Pat. 6,055,314), in view of **Crawford** (US Pat. 6,014,651).

Spies et al. suggest a method that:

- determining a machine identifier of a client by computer hardware configuration, then transmitting said identifier to a server (see **Spies**, claim 15);

In addition of **Spies**'s patent, **Crawford** patent also gave ideas of:

- combining said transmitting identifier with a cryptographic key to form a unique determinator for the client,
- transmitting the unique determinator to the client, to be stored therein for use subsequently in identifying the client to the server, to permit encrypted data to be downloaded thereto from the server.

It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated **Crawford's** suggestion to **Spies** invention to suggest claimed step because it would use an available form such as steganographic marked data for data protection purposes.

15. As per claim 21: The examiner submits that this claim contains same limitations as claim 31; therefore, similar rationales and reference set forth for 35 USC 103(a) rejections of claim 31 are applied.

16. As per claim 28: The examiner submits that this claim contains same limitations as claim 32; therefore, similar rationales and reference set forth for 35 USC 102(e) rejections of claim 31 are applied.

17. As per claim 29: The examiner submits that this claim contains same limitations as claim 31 although "a computer program carrier medium" is claimed because all limitations are similar to claim 31; therefore, similar rationales and reference set forth for 35 USC 103(a) rejections of claim 31 are applied.

18. As per claim 30: The examiner submits that this claim contains same limitations as claim 31; therefore, similar rationales and reference set forth for 35 USC 102(e) rejections of claim 31 are applied.

19. As per claim 33: The examiner submits that this claim contains same limitations as claim 31; therefore, similar

rationales and reference set forth for 35 USC 102(e) rejections of claim 31 are applied.

Conclusion

20. Claims 1-8, 12, 14-18, 21-26, and 28-33 are unpatentable.

21. These references are considered pertinent to applicants' disclosure:

- **Ginter** et al., (US Pat. 5,949,876), Systems and methods for secure transaction management and electronic rights protection.

- **Rhoads** (US Pat. 5,841,978 - 11/24/1998, US class. 709/217) discloses a network linking method using steganographically embedded data objects; wherein a given data object can effectively contain both a graphical representation to a network user and embedded information, such as the URL address of another network node, thereby to permit the object itself to serve as an automated hot link. The underlying development tools and web site browsers create and identify such an object for use in a manner similar to a hot link, as provided on the World Wide Web.

22. Note: The examiner submits that in pending claims, particular language does not serve as a limitation on the claim.

i. Since this case is for a utility patent, the claims must be directed to systems, methods or articles of manufacture

that have a clear utility. See MPEP 706.03(a) . Over the years, numerous court decisions have analyzed the content of various claimed language for meaningful, useful differences in structure or acts performed between the claims and the prior art. Some of these decision have found that certain language adds little, if anything, to the claimed structure or acts and thus do not serve as a limitation on the claims to distinguish over the prior art. For example, language directed to an intended use of dispensing popcorn in a claim for a product did not result in a structural or functional difference with respect to prior art and were held not to serve as a limitation on the claim. See in re **Schreiber**, 44 USPQ2d 1429 (CAFC 1997).

ii. Thus, a limitation on a claim can broadly be thought of then as its ability to make a meaningful contribution to the definition of the invention in a claim. In other words, language that is not functionally interrelated with the useful acts, structure, or properties of the claimed invention will not serve as a limitation. See in re **Gulack**, 217 USPQ 401 (CAFC 1983), ex parte **Carver**, 227 USPQ 465 (BdPatApp&Int 1985) and in re **Lowry**, 32 USPQ2d 1031 (CAFC 1994) where language provided certain limitations because of specific relationships required by the claims.

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cuong

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H. Nguyen whose telephone number is 703-305-4553. The examiner can normally be reached on Mon.-Fri. from 7:15 AM to 3:15 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins, can be reached on (703)308-1344.

Any response to this action should be mailed to:

Amendments

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to: 703-746-5572 (RightFax)

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist. Receptionist's telephone: (703)308-1113.

Cuonghnguyen

Nov. 07, 2002